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Attorney Docket: 16528A-038900US

Assistant Commission for Patents
Washington, DC 20231

On: 11-7-01

TOWNSEND and TOWNSEND and CREW, LLP

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In re application of:

Reidhaar-Olson, John F.

Application No.: 09/489,220

Filed: January 21, 2000

For: TOXICANT-INDUCED
DIFFERENTIAL GENE
EXPRESSION

Examiner: Lu, Frank

Art Unit: 1655

RESPONSE TO NOTICE OF IMPROPER
REQUEST FOR CONTINUED
EXAMINATION (RCE)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Response responds to a Notice of Improper Request for Continued Examination (RCE) having a mailing date of October 11, 2001.

The Notice alleges that this application is a constructive RCE, and therefore the request for Continued Prosecution Application (CPA) filed on October 1, 2001, is allegedly improper for not being accompanied by the fee set forth in 37 CFR § 1.17(e) as required by 37 CFR § 1.114.

It is submitted that this is not a Request for Continued Examination but rather a Continued Prosecution Application (CPA) as provided in 37 CFR § 1.53(d). The original application was filed on January 21, 2000 which was prior to May 29, 2000. Under 37 CFR § 1.53(d) there is no requirement that a filing fee be accompanied by a Request for Continued Prosecution Application. To be accorded the filing date of a Continued Prosecution Application, all that is required under 37 CFR § 1.53(d) is that the application filed under this section must include the following five requirements:

- (1) must identify the prior application;

- (2) discloses and claims only subject matter disclosed in the prior application;
- (3) names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;
- (4) includes a request for an application under this paragraph; and
- (5) is a request to expressly abandon the prior application as the filing of the request for an application under this paragraph. See 37 CFR § 1.53(d)(2).

All of these requirements were met in a Request for Continued Prosecution Application that was filed on October 1, 2001.

Another requirement for filing a Continued Prosecution Application is that the prior non-provisional application is a complete utility application as defined in 37 CFR § 1.51(b) and filed under 35 U.S.C. § 111(a) before May 29, 2000. See 37 CFR § 1.53(d)(1)(i)(A). Under 37 CFR § 1.51(b) a complete application comprises a specification, an oath or declaration, drawings, when necessary, and the prescribed filing fees. The previous non-provisional application was filed on January 21, 2000. A Declaration and the prescribed filing fee was submitted on May 24, 2000. A copy of the Response to Notice of Missing Parts is enclosed herewith for the Examiner's convenience.

Accordingly, it is submitted that a complete prior non-provisional utility application as defined in 37 CFR § 1.51(b) was filed prior to May 29, 2000. Therefore, the Request for Continued Prosecution Application (CPA) filed on October 1, 2001 cannot be a constructive RCE. A Petition for three-months Extension of Time and the corresponding fee were also submitted on October 1, 2001, thereby extending the due date for filing a response to the previous non-provisional application from June 30, 2001 to October 1, 2001, because September 30, 2001 is a Sunday. Thus, it is submitted that the Request for Continued Prosecution Application was timely filed.

In addition, as the copy of the enclosed Fee Transmittal Sheet shows, the Examiner was authorized to charge any additional fee required under 37 CFR § 1.16 and 1.17. Therefore, any fee that was deemed to be necessary should have been charged to the Deposit Account No. 20-1430 as authorized in the Fee Transmittal Sheet.

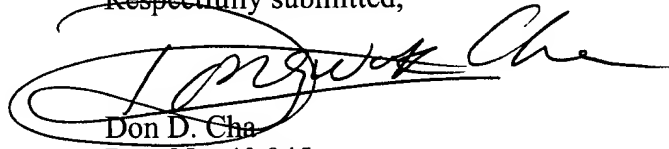
Reidhaar-Olson, John F.
Application No.: 09/489,220
Page 3

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In view of the foregoing, Applicant respectfully requests withdrawal of a Notice of Improper Request for Continued Examination.

If the Examiner believes a telephone conference would expedite resolution of this matter, please telephone the undersigned at 303.571.4000.

Respectfully submitted,



Don D. Cha
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